

REMARKS

Claims 1-28 and 30-33 are now pending and stand rejected. Applicants are submitting a Request for Continued Consideration (RCE) with this Preliminary Amendment. By this Preliminary Amendment, Applicants have amended the claims and demonstrate reasons why the claims pending here are distinct from the asserted art. In particular, Applicants have amended claims 1, 14, and 27. In view of the above amendments and the reasoning shown below, Applicants respectfully request the Examiner to reconsider the outstanding rejections and to withdraw them.

35 U.S.C. § 103 Rejections

Governing Criteria

At the outset, Applicants acknowledge the Examiner's reasoning but additionally urge the following legal reasoning and case law as the bases for rejections under 35 U.S.C. Section 103. For obviousness rejections, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03

To resolve the issue of patentability based on obviousness, the Examiner must not only look to the teaching in the asserted references that meets the claimed limitations, but must also point to the motivation in the asserted references that invites a combination in the event one reference is devoid of a particular teaching. Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796

F.2d 436, 442 (Fed. Cir. 1986)). Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993).

An Examiner may often find every element of a claimed invention in the prior art. "Virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Discussion of the Rejections

The Examiner continues to reject claims 1-28 and 30-33 as unpatentable under 35 U.S.C. Section 103 over Watanabe et al. ("Watanabe") in view of Mousseau et al. ("Mousseau et al."). Specifically, in paragraphs 4-19 of the office action, the Examiner rejects claims 1-28 and 30-33,

stating that it would have been obvious for one of ordinary skill in the art to combine the two references. The dependent claims are distinct at least for the reasons by which the independent claims are distinct.

With respect to the independent claims 1 and 27, the Examiner assumes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Watanabe with Mousseau and indicates that the motivation for such a combination *"would have been developing [a] system for pushing/notifying from a host system to user's mobile device based on the user-defined elements."* With respect to the remaining dependent claims, the Examiner relies on the same bases for rejecting the independent claims as well as additional bases. The Examiner takes the following position that:

Watanabe is silent about having a standard electronic mail protocol for receiving said copy of said electronic mail message as a standard formatted electronic mail messages. However, *Simple Mail Transfer*, a protocol for sending e-mail messages between servers; Most e-mail systems that send mail over the Internet use SMTP to send messages from one server to another; the messages can then be retrieved with an e-mail client using either POP or IMAP; In addition, SMTP is generally used to send messages from a mail client to a mail server; SMTP, POP, or IMAP e-mail server are known in the art. For example, Mousseau discloses having a standard electronic mail protocol for receiving said copy of said electronic mail message as a standard formatted electronic mail messages. (page 6, paragraph #0062; page 9, paragraph 0084). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Watanabe and Mousseau. The motivation (Watanabe, col 1, lines 39-44, mail notification) would have been developing system for pushing/notifying from a host system to user's mobile device based on the user-defined events.

Applicant respectfully submits that neither Watanabe nor Mousseau are confronted with the same set of problems as the present application because if that were the case, either one would satisfy the claims here on its own, without requiring a combination in the manner that the Examiner suggests. Applicant respectfully submits that the Examiner's rejection for obviousness is based on his own reasoning and not on a suggestion in the cited prior art references, either singly or in combination, that suggests the desirability of the claimed subject matter.

The Examiner has cited the following disclosure in Watanabe to base the rejection of the claims here.

1. Field of the Invention

This invention relates to a mail notification apparatus and method that notifies the arrival of an electronic mail.

('757, col. 1, lines 5-10)

FIG. 1 is a schematic view illustrating a network on which a mail notification apparatus 100 operates, according to an embodiment of the present invention.

As shown in FIG. 1, the mail notification apparatus 100 of the present invention is, for example, provided on a LAN 101 built in a company. A local mail server 102 and local mail clients 103, each of which is embodied, for example, as a PC, and so on, are connected to the LAN 101. The mail notification apparatus 100 is further connected to the Internet 104 via the LAN 101. Thus, the mail notification apparatus 100 of the present invention is capable of accessing a mail server 105 of a communication vender (hereinafter "communication vender mail server").
('757, col. 2, lines 24-36)

FIG. 1 is a schematic view illustrating a network on which a mail notification apparatus 100 operates, according to an embodiment of the present invention.

As shown in FIG. 1, the mail notification apparatus 100 of the present invention is, for example, provided on a LAN 101 built in a company. A local mail server 102 and local mail clients 103, each of which is embodied, for example, as a PC, and so on, are connected to the LAN 101. The mail notification apparatus 100 is further connected to the Internet 104 via the LAN 101. Thus, the mail notification apparatus 100 of the present invention is capable of accessing a mail server 105 of a communication vender (hereinafter "communication vender mail server").

The local mail server 102 receives an electronic mail from the Internet 104 via the LAN 101. Then, the local mail server 102 stores the received electronic mail into a mailbox corresponding to a mail address of the electronic mail. The local mail client 103 accesses the local mail server 102, at a predetermined time or in response to a predetermined instruction. When an electronic mail is stored in a corresponding mailbox, the local mail client 103 retrieves the electronic mail. Thus, the local mail client 103 can receives an electronic mail from the Internet 104.
('757, col. 2, lines 24-46)

In addition, the mail address conversion table further stores a mail address 303 of the cellular phone 106 (hereinafter "cellular phone mail address") in association with the local mail account 301 and the password 302. ('757, col. 3, lines 33-35)

After determining whether the arrived (received) electronic mail is a multipart mail, the mail notification apparatus 100 establishes a connection to the communication vender mail server 105 through the LAN 101 and the Internet 104 (ST409). Here, it is assumed that the IP address of the communication vender mail server 105 is preset to the mail notification apparatus 100.

Since the arrived (received) electronic mail is a multipart mail, the mail notification apparatus 100 transmits an arrival notification mail for the multipart mail to the cellular phone mail address 303 in the mail account data currently being read (ST410). In other words, the mail notification apparatus 100 notifies, by using electronic mail, the cellular phone mail address 303 in the mail account data currently being read, of the arrival of an electronic mail and the fact that the electronic mail is a multipart mail.

More specifically, the mail notification apparatus 100 sends a predetermined (standard) message with a fixed form to the cellular phone mail address 303b "09023456789@xxx.co.jp", corresponding to "Saburo.Matsushita" 301b, to notify the arrival of an electronic mail and the fact that the electronic mail is a multipart mail. The standard message include a couple of short sentences, such as "An electronic mail has arrived. The arrived electronic mail is a multipart mail. The cellular phone 106 displays the message on a display portion, such as a LCD display, and so on. ('757, col. 5, lines 6-31)

After determining whether the arrived (received) electronic mail is a multipart mail, the mail notification apparatus 100 establishes a connection to the communication vender mail server 105 through the LAN 101 and the Internet 104 (ST409). Here, it is assumed that the IP address of the communication vender mail server 105 is preset to the mail notification apparatus 100.

Since the arrived (received) electronic mail is a multipart mail, the mail notification apparatus 100 transmits an arrival notification mail for the multipart mail to the cellular phone mail address 303 in the mail account data currently being read (ST410). In other words, the mail notification apparatus 100 notifies, by using electronic mail, the cellular phone mail address 303 in the mail account data currently being read, of the arrival of an electronic mail and the fact that the electronic mail is a multipart mail.

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More specifically, the mail notification apparatus 100 sends a predetermined (standard) message with a fixed form to the cellular phone mail address 303b "09023456789@xxx.co.jp", corresponding to "Saburo.Matsushita" 301b, to notify the arrival of an electronic mail and the fact that the electronic mail is a multipart mail. The standard message include a couple of short sentences, such as "An electronic mail has arrived. The arrived electronic mail is a multipart mail. The cellular phone 106 displays the message on a display portion, such as a LCD display, and so on.

Accordingly, the user of the cellular phone 106 can know that an electronic mail has arrived at the mail address corresponding to the local mail client 103, even when he/she is away from his/her office.

Accordingly, the user of the cellular phone 106 can take some necessary actions, for example, can read the arrived (received) electronic mail at a PC in the place away from his/her office.

(757, col. 5, lines 6-39)

No where does Watanabe describe the motivation of "developing a system for pushing/notifying from a host system to a user's mobile device based on the user-defined events. The Examiner is urged to reconsider his rejection based on the legal construct provided here.

Conclusion

Applicant respectfully requests the Examiner to consider the legal reasoning, amendments and arguments urged here and to allow this application.

Respectfully submitted,

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